



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,328	01/20/2006	Alois Maier	HUBR-1291	2248
24972	7590	10/28/2008		
FULBRIGHT & JAWORSKI, LLP				
666 FIFTH AVE				
NEW YORK, NY 10103-3198				
EXAMINER				
NILAND, PATRICK DENNIS				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
10/28/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/565,328

**Applicant(s)**

MAIER ET AL.

**Examiner**

Patrick D. Niland

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 August 2008 and 17 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-36, 38-45 and 47-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-36, 38-45 and 47-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/19/08 has been entered.

The amendment of 8/19/08 and 7/17/08 has been entered. Claims 26-36, 38-45, and 47-53 are pending.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 26-36, 38-45, 47-51, and 53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The instant claim 26 and consequently the claims which depend therefrom recite numerous recitations of "consisting" but also recite "comprising" in component A. It is unclear what is intended by the claimed combination of open and closed language.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 26-36, 38-45, and 47-53 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 6462127 Ingrisch et al..

Ingrisch discloses the instantly claimed polyurethane dispersions at the abstract; column 1, lines 4-67; column 2, lines 1-67; column 3, lines 1-67, particularly 44-67 which broadly encompasses the instantly claimed invention; column 4, lines 1-67, particularly 18-67, which encompasses the instantly claimed ingredients and amounts thereof. It is noted that the instant claim recites ">12" regarding component A and the disclosure's preferred amount of the instantly claimed component A is 0.3-12%. However, the instant claims recite "comprise", which encompasses the instant components of the patentee. The instantly claimed amounts appear to be based only on the claimed components, not the additional components encompassed by "comprise". The ingredients of column 5, lines 1-8 are additional to those of the instant claims. Taking the amounts of column 5, lines 1-8 of the patentee from the patentee's composition and using the larger amounts of the instantly claimed component A of the patentee gives amounts within those of the instant claims since removing the amounts of column 5, lines 1-8 lowers the amount of the denominator used to calculate the amounts. Furthermore, the amounts overlap due to experimental error in making such measurements and because the broader disclosure of the patentee encompasses larger than the preferred amounts of the instantly claimed component A. Note also column 5, lines 9-67; column 6, lines 1-67, column 7, lines 1-67; column 8, lines 1-67; column 9, lines 1-67; column 10, lines 1-19, which encompasses the instantly claimed high molecular weight; ; column 11, lines 18-67; column 12, lines 1-67; column 13, lines 1-44 which discloses the instantly claimed substrates; and the remainder of the

document which encompasses the limitations of the remaining claims, particularly the examples and the claims.

The applicant argues "Applicants respectfully submit that due to the amendment the presently claimed polyurethane dispersion consisting of components A-G is novel over the dispersion described by Ingrisich, which in addition to components A-G, also comprises components H and E." This argument is not persuasive because claim 26 recites "comprising" in ingredient A, which is taken as encompassing the additional ingredients of the reference. The instant claim 47 is a method that recites "comprising" and therefore includes the addition of other ingredients due to the open nature of the claim. The instant claim 26 and consequently the claims which depend therefrom recite numerous recitations of "consisting" but also recite "comprising" in component A. This instance of open language is taken as reading on the additional components of the patentee. Column 11, lines 31-48, particularly 44-48 show that the polyurethane dispersion not containing H and I of the patentee is prepared and exists for a finite period of time without the presence of H and I of the patentee. This existence meets the requirements of the instant claim 52 in that the intermediate does not contain anything excluded by the recitations of "consisting" of the instant claims. The rejection is maintained for the above reasons.

7. Claims 26-36, 38-45, and 47-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6462127 Ingrisich et al..

Ingrisich discloses the instantly claimed polyurethane dispersions at the abstract; column 1, lines 4-67; column 2, lines 1-67; column 3, lines 1-67, particularly 44-67 which broadly encompasses the instantly claimed invention; column 4, lines 1-67, particularly 18-67, which encompasses the instantly claimed ingredients and amounts thereof. It is noted that the instant

claim recites ">12" regarding component A and the disclosure's preferred amount of the instantly claimed component A is 0.3-12%. However, the instant claims recite "comprise", which encompasses the instant components of the patentee. The instantly claimed amounts appear to be based only on the claimed components, not the additional components encompassed by "comprise". The ingredients of column 5, lines 1-8 are additional to those of the instant claims. Taking the amounts of column 5, lines 1-8 of the patentee from the patentee's composition and using the larger amounts of the instantly claimed component A of the patentee gives amounts within those of the instant claims since removing the amounts of column 5, lines 1-8 lowers the amount of the denominator used to calculate the amounts. Furthermore, the amounts overlap due to experimental error in making such measurements and because the broader disclosure of the patentee encompasses larger than the preferred amounts of the instantly claimed component A. Note also column 5, lines 9-67; column 6, lines 1-67, column 7, lines 1-67; column 8, lines 1-67; column 9, lines 1-67; column 10, lines 1-19, which encompasses the instantly claimed high molecular weight; ; column 11, lines 18-67; column 12, lines 1-67; column 13, lines 1-44 which discloses the instantly claimed substrates; and the remainder of the document which encompasses the limitations of the remaining claims, particularly the examples and the claims.

It would have at least been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the ingredients and amounts thereof and the reaction parameters of the instant claims in making the dispersions of the patentee because these are encompassed by the disclosure of the patentee and would have been expected to give the properties of the dispersions of the patentee. It would have at least been obvious to one of

ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed amounts of the instantly claimed component A in the dispersions of the patentee because using one % more than the upper level of the preferred amounts of the patentee that read on the amounts of the instant claims will not give a significantly different result and will give only predictable results to the ordinary skilled artisan, i.e. 12% to 13% is not expected to give much difference and is encompassed by the broad disclosure of the patentee as preferred mode does not teach away from other values and the broad disclosure encompasses broader values of the amount of A. The applicant's arguments have been fully considered but are not persuasive for the reasons stated above and the teachings of the patentee.

The applicant argues "Applicants respectfully submit that due to the amendment the presently claimed polyurethane dispersion consisting of components A-G is novel over the dispersion described by Ingrisich, which in addition to components A-G, also comprises components H and E." This argument is not persuasive because claim 26 recites "comprising" in ingredient A, which is taken as encompassing the additional ingredients of the reference. The instant claim 47 is a method that recites "comprising" and therefore includes the addition of other ingredients due to the open nature of the claim. The instant claim 26 and consequently the claims which depend therefrom recite numerous recitations of "consisting" but also recite "comprising" in component A. This instance of open language is taken as reading on the additional components of the patentee. Column 11, lines 31-48, particularly 44-48 show that the polyurethane dispersion not containing H and I of the patentee is prepared and exists for a finite period of time without the presence of H and I of the patentee. This existence meets the requirements of the instant claim

52 in that the intermediate does not contain anything excluded by the recitations of “consisting” of the instant claims. The rejection is maintained for the above reasons.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Patrick D Niland/  
Primary Examiner  
Art Unit 1796